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PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER NGUYEN BA, HOANG VU A	
			ART UNIT 2421	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/037,938

**Applicant(s)**

HOFFMANN ET AL.

**Examiner**

Hoang-Vu A. Nguyen-Ba

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 10/29/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the amendment filed June 26, 2006 and the filing of IDS on October 29, 2008.
2. Claims 1-31 are pending. Claims 1, 16 and 31 are independent claims.

#### ***Information Disclosure Statement***

3. The Office acknowledges receipt of the Information Disclosure Statement filed October 29, 2008. It has been placed in the application file and the information referred to therein has been considered.

#### ***Response to Arguments***

4. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 1-15 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-15 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an

article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

7. Claims 16-31 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-31 merely recite software components, i.e., computer program per se. Such claimed matter, which is functional descriptive material per se, is not statutory because it is not a physical "thing" nor a statutory process as there are no "acts" being performed. Such claimed computer program does not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer's program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable storage medium needed to realize the computer's functionality. In contrast, a claimed computer-readable storage medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus mandatory. *Warmerdam*, 33 F.2d at 1361, 31 USPQ 2d at 1760. In *re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 178). See MPEP §2106 (IV)(B)(1)(a).

#### ***Claim Rejections – 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 10, 11, 16, 25, 26, and 31 rejected under 35 U.S.C. § 102(b) as being anticipated by Design Patterns Elements of Reusable Object-Oriented Software by Gamma et al. ("Gamma").

It should be noted that hereinafter the use of the clause "see at least" should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

### **Claims 1, 16, and 31**

Gamma discloses at least *a method and a system for developing an application, comprising:*

*selecting one of a plurality of patterns, each of said plurality of patterns having at least one of a plurality of business artifacts* (see at least p. 42, e.g., How to Select a Design Pattern; p. 18, e.g., The Catalog of Design Patterns);

*designing said application using said at least one of said plurality of business artifacts associated with said selected one of said plurality of patterns* (see at least p. 12; p. 14; p. 16; p. 23, e.g., How Design Pattern Solve Design Problems; p. 24-41);

*generating code based on said at least one of said plurality of business artifacts* (p. 113; p. 366; p. 374);  
*and*

*interfacing said code with at least one platform independent service* (see at least p. 25, e.g., "Specifying Object Interfaces"; p. 30, e.g., "Programming to an Interface).

### **Claims 10 and 25**

The rejection of the respective base claim is incorporated. Gamma further discloses:

*wherein said platform independent services include logging services, security services, messaging services and transaction services* (Gamma; see at least p. 266, 3<sup>rd</sup> and 4<sup>th</sup> paragraphs).

**Claims 11 and 26**

The rejection of the respective base claim is incorporated. Gamma further discloses:  
*interfacing said at least one platform independent service with a platform specific adapter* (see at least p. 43, Adapter (157)).

***Claim Rejections – 35 USC § 103***

10. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 12 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Design Patterns Elements of Reusable Object-Oriented Software by Gamma et al. (“Gamma”), as applied to the respective base claim, and in view of official notice.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

**Claims 12 and 27**

Rejections of the respective base and intervening claims are incorporated. Gamma does not specifically disclose:

*wherein said platform specific adapter is selected from a group including an NT adapter, a Solaris adapter and a S390 adapter.*

However, official notice is taken that NT, Solaris and S/390 are well known operating systems.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Gamma to design adapter to interface with these well known operating systems because the design of adapters to these systems using Gamma would help new application programs to work compatibly with legacy application programs written for these platforms.

12. Claims 2, 3, 4, 5, 6, 7, 8, 9, 13, 14, 15, 17, 18, 19, 20, 21, 22, 23, 24, 28, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Design Patterns Elements of Reusable Object-Oriented Software by Gamma et al. ("Gamma"), as applied to the respective base claim, in view of U.S. Patent No. 6,601,233 to Underwood.

#### **Claims 2 and 17**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said plurality of patterns includes a process workflow application pattern (see at least 33:38-40), service request application pattern (see at least 25:2-5), web-based application pattern (see at least 5:45-46; 5:62-64; 16:18-24) and a reporting pattern (see at least 6:64-65); 9:32-35).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

#### **Claims 3 and 18**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said plurality of business artifacts (see at least Abstract) includes a process business artifact (see at least 2:30-34), an activity business artifact (see at least 3:45-50), a user interface business artifact (see at least 3:65-66), a business object (see at least 11:45-56), business artifact (see at least 11:45-56) and a data business artifact (see at least 5:19-22).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

#### **Claims 4 and 19**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said plurality of patterns include a process workflow application pattern (see at least 33:38-40), and said at least one of said plurality of business artifacts associated with said process workflow application pattern includes a process business artifact (see at least 2:30-34), an activity business artifact (see at least 3:45-50), a user interface business artifact (see at least 3:65-66), a business object (see at least 11:45-56), business artifact (see at least 11:45-56) and a data business artifact (see at least 5:19-22).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

#### **Claims 5 and 20**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:



*wherein said plurality of patterns include a service request application pattern (see at least 25:2-5) and said at least one of said plurality of business artifacts associated with said service request application pattern includes an activity business artifact (see at least 3:45-50), a business object (see at least 11:45-56), business artifact (see at least 11:45-56) and a data business artifact (see at least 5:19-22).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

#### **Claims 6 and 21**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said plurality of patterns include a web-based application pattern (see at least 5:45-46) and said at least one of said plurality of business artifacts associated with said web-based application pattern includes a user-interface business artifact (see at least 3:65-66), a business object (see at least 11:45-56), business artifact (see at least 11:45-56), and data business artifact (see at least 5:19-22).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

#### **Claims 7 and 22**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said plurality of patterns include a reporting pattern (see at least 6:64-65; 9:32-35) and said at least one of said plurality of business artifacts associated with*

*said reporting pattern includes a user interface business artifact (see at least 3:65-66), and a data business artifact (see at least 5:19-22).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

### **Claims 8 and 23**

The rejection of the respective base claim is incorporated. Gamma further discloses:

*interfacing said code with said at least one platform independent service (see at least p. 25, e.g., "Specifying Object Interfaces"; p. 30, e.g., "Programming to an Interface).*

Gamma does not specifically disclose *via said business artifact services*.

However, in an analogous art, Underwood discloses the aforementioned feature at 16:39-65; 14:38-57).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

### **Claims 9 and 24**

Rejections of the respective base and intervening claims are incorporated. The combination Gamma-Underwood further discloses:

*wherein said business artifact services includes a workflow framework (Underwood; see at least 33:38-40), an activity framework (Underwood; see at least 3:45-50), user interface services (Underwood; see at least 3:65-66), a business object framework (Underwood; see at least 11:45-56), and database application (Underwood; see at least FIGs. 17A-B).*

### **Claims 14 and 29**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose the feature of these claims.

However, in an analogous art, Underwood discloses:

*wherein said application is to be modified and wherein the method further comprises the steps of:*

*changing at least one of said plurality of business artifacts associated with said selected one of said plurality of patterns (see at least 21:15-20); and*

*regenerating code based on said at least one of said plurality of business artifacts (see at least 20:34-38).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Underwood with Gamma because the combination would help speed up the development of business software by re-using code already written for standard business functions and patterns.

### **Claims 15 and 30**

The rejection of the respective base claim is incorporated. Gamma does not specifically disclose:

*wherein the step of generating code includes the step of:*  
*converting said code into an executable format.*

However, in an analogous art, Underwood discloses the conversion of said code into executable code at least at 17:34-38.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the conversion of code into executable code as taught in Underwood because this would allow the written code to in executable format and ready to be run by users.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu “Antony” Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner’s supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/  
Primary Examiner, Art Unit 2421  
December 21, 2008